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EXAMINER
YOUNG, JOHN L

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/852,497	Vigil et al.
Examiner	**Art Unit**
John Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 12, 2003*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-82* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-82* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

8-11-03

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

FINAL REJECTION

(PAPER#16)

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

2. **REJECTIONS MAINTAINED (Claims 1-77).**

PROVISIONAL CLAIM REJECTIONS (MAINTAINED)

35 USC §101 Statutory Type Double Patenting(Same Invention)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 of application 09/852,497 is rejected under 35 USC §101 for same invention type double patenting for claiming the same invention as application 09/568,292.

3. For example:

Claim 1 Vigil et al. application 09/568,292:

1. A method of advertising to a viewer wherein by viewing an advertisement a viewer may qualify to win a prize, comprising:

transmitting an advertisement to a viewer;

transmitting to the viewer an offer to submit an entry to win a prize in response to the advertisement wherein the viewer is offered the opportunity to submit the entry only after the advertisement has been displayed to the viewer for a period of time;

receiving an entry for the prize from the viewer; and

selecting an entry as a winning entry to receive a prize.

Claim 1 Vigil et al. application 09/852,497:

1. A system of advertising to a viewer wherein by viewing an advertisement a viewer may qualify to win a prize, comprising:

transmitting an advertisement to a viewer;

transmitting to the viewer an offer to submit an entry to win a prize in response to the advertisement wherein the viewer is offered the opportunity to submit the entry only after the advertisement has been displayed to the viewer for a period of time;

receiving an entry for the prize from the viewer; and

selecting an entry as a winning entry to receive a prize.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-77 are rejected under 35 U.S.C. §103(a) as being obvious over Small 5,791,991 (8/11/1998) (herein referred to as "Small") in view of De Rafael 6,529,878 (03/04/2003) [US f/d: 03/19/1999] (herein referred to as "De Rafael").

As per independent claim 1, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 1.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the

teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 2, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 2.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill

in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 3, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 3.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 3, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses *"users . . . who viewed a certain advertisement . . . within a certain time. . . ."*

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 4-21, Small in view of De Rafael shows the system of claim 3 and subsequent base claims depending from claim 3. (See the rejection of claim 3 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 4-21.

Small lacks an explicit recitation of the elements and limitations of claims 4-21, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 4-21 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 22, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 22.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 23, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 23.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 23, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 24-40, Small in view of De Rafael shows the system of claim 23 and subsequent base claims depending from claim 23. (See the rejection of claim 23 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 24-40.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 24-40, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 24-40 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 41, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 41.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 41, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 42-59, Small in view of De Rafael shows the system of claim 41 and subsequent base claims depending from claim 41. (See the rejection of claim 41 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 42-59.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 42-59, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 42-59 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 60, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 60.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 60, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 61 Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 61.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 61, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col.

1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 62-72, Small in view of De Rafael shows the system of claim 61 and subsequent base claims depending from claim 61. (See the rejection of claim 61 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25)

in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 62-72.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 62-72, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 62-72 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 73, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 73.

Small lacks an explicit recitation of the "the advertisement being displayed for a time period. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll.

19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 74, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 74.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claim 75, Small in view of De Rafael shows the system of claim 66. (See the rejection of claim 66 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claim 75.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 75, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 75 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 76-77, Small in view of De Rafael shows the system of claims 1-75 and subsequent base claims depending from claims 1-75. (See the rejection of claims 1-75 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 76-77.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 76-77, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 76-77 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

NEW CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 78-82 are rejected under 35 U.S.C. §103(a) as being obvious over Small in view of De Rafael.

Independent claim 78 is rejected for substantially the same reasons as independent claim 1.

Independent claim 79 is rejected for the same reasons as independent claim 1.

Independent claim 80 is rejected for substantially the same reasons as independent claim 1.

Independent claim 81 is rejected for substantially the same reasons as independent claim 1.

Independent claim 82 is rejected for substantially the same reasons as independent claim 79.

RESPONSE TO ARGUMENTS

6. Applicant's arguments (Amendment B, paper#15, filed 05/12/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

As per dependent claims 4-21, 24-40, 42-59, 62-72, 75 and 76-77, in response to Applicant's argument (Amendment B; paper#15; p. 4, ll. 11-25; p. 12, ll. 1-2; p. 6, ll. 14-17; p. 9, ll. 21-22; and p. 10, ll. 1-18) which assets that "Applicants' respectfully disagree. . . ." that Applicant failed to seasonably challenge the Official Notice evidence presented in the obviousness rejections of Office Action (Paper#11, filed 9/9/2002), it is well settled in the law that "If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03).

In this case, Applicant's responses are silent as to a demand for references concerning the Officially Noticed well known statement evidence presented in the prior Office Action; therefore, said Official Notice evidence is deemed admitted, and no further references are required in support of said Official Notice evidence.

Applicant's argument (Amendment B; paper#15; p. 5, ll. 3-21; p. 6, ll. 10-13; p. 6, ll. 18-22; and p. 12, ll. 19-22) alleges that "Small does not teach or suggest providing an opportunity to win a prize only after the viewer has watched the advertisement for

some minimum period of time. . . . [and therefore] Claims 1-77 [and new claims 78-82] would not have been obvious over Small in view of De Rafael because neither Small nor De Rafael teach or suggest at least . . . a minimum initial advertisement viewing period before being able to submit an entry to win a prize as claimed in claims 1-77 [and new claims 78-82." This is not the case.

In this case as cited in the prior Office Action, Small (FIG. 2, el. 73) discloses: *"SEND SCREEN DISPLAY 4 (OR 61) TO PC 15 FOR DISPLAY ON MONITOR 24".*

Small (FIG. 2, el. 75) discloses: *"CONSUMER SCROLLS THROUGH PRODUCT CATEGORIES 47 AND SELECTS THOSE OF INTEREST".* The Examiner interprets this disclosure as showing "the viewer has watched the advertisement for some minimum period of time."

Small (FIG. 2, el. 82) discloses: *"BINGO GAME SELECTED CATEGORY #'S ARE COMPARED WITH BINGO SPACES AND MATCHED SPACES ARE REVEALED".*

Small (FIG. 2, el. 85) discloses: *"FLASH WINNING MESSAGE AND PAYMENT METHOD MENU ON SCREEN".*

Small (FIG. 2, el. 92) discloses: *"REMIT PRIZE PAYMENT".* The Examiner interprets the above combined disclosures of Small as suggesting that "Small does . . . teach or suggest providing an opportunity to win a prize only after the viewer has watched the advertisement for some minimum period of time."

As per Applicant's argument (Amendment B; paper#15; p. 6, ll. 4-9), the Examiner agrees that the rejection of claim 1 under 35 U.S.C. §101 same invention type double patenting is provisional.

As per Applicant's argument (Amendment B; paper#15; p. 6, ll. 18-20; p. 7, ll. 1-2; p. 7, ll. 5-22; p. 8, ll. 20-22; and p. 9, ll. 1-8) alleges that "neither Small nor De Rafael teach or suggest at least . . . a limitation of the period of time during which the view may submit an entry to win a prize as claimed in Claims 3, 23, and 41 and the claims that depend therefrom. . . ." This is not the case.

In this case as cited in the prior Office Action, Small (FIG. 2, el. 73) discloses: *"SEND SCREEN DISPLAY 4 (OR 61) TO PC 15 FOR DISPLAY ON MONITOR 24".*

Small (FIG. 2, el. 75) discloses: *"CONSUMER SCROLLS THROUGH PRODUCT CATEGORIES 47 AND SELECTS THOSE OF INTEREST".* The Examiner interprets this disclosure as showing "the viewer has watched the advertisement for some minimum period of time."

Small (FIG. 2, el. 82) discloses: *"BINGO GAME SELECTED CATEGORY #'S ARE COMPARED WITH BINGO SPACES AND MATCHED SPACES ARE REVEALED".* The Examiner interprets this disclosure as showing that a first period of time during which the viewer may submit an entry to win a prize.

Small (FIG. 2, el. 98) discloses: *"FOR KENO GENERATE RANDOM KENO NUMBERS AND COMPARE AGAINST SELECTIONS"*. The Examiner interprets this disclosure as showing that a second period of time during which the viewer may submit an entry to win a prize.

Small (FIG. 2, el. 85) discloses: *"FLASH WINNING MESSAGE AND PAYMENT METHOD MENU ON SCREEN"*.

Small (FIG. 2, el. 92) discloses: *"REMIT PRIZE PAYMENT"*. The Examiner interprets the above combined disclosures of Small as suggesting that "Small does . . . teach or suggest providing an opportunity to win a prize only after the viewer has watched the advertisement for some minimum period of time."

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 3, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses *"users . . . who viewed a certain advertisement . . . within a certain time. . . ."*

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of

"targeting . . . advertisements and responding to consumer preferences. . . ." (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)). The Examiner interprets the above combined disclosures of Small in view of De Rafael as showing "a limitation of the period of time during which the view may submit an entry to win a prize as claimed in Claims 3, 23, and 41 and the claims that depend therefrom. . . ."

As per Applicant's argument (Amendment B; paper#15; p. 6, ll. 18-20; p. 7, ll. 3-4; p. 11, ll. 18-22; and p. 12, ll. 1-12) alleges that "neither Small nor De Rafael teach or suggest at least . . . displaying individual advertisements to a viewer in series as claimed in Claims 23, 62 and 75 and the claims that depend therefrom." This is not the case.

In this case as cited in the prior Office Action, Small (FIG. 2, el. 73) discloses: *"SEND SCREEN DISPLAY 4 (OR 61) TO PC 15 FOR DISPLAY ON MONITOR 24".*

Small (FIG. 2, el. 75) discloses: *"CONSUMER SCROLLS THROUGH PRODUCT CATEGORIES 47 AND SELECTS THOSE OF INTEREST".* The Examiner interprets this disclosure as showing "the viewer has watched the advertisement for some minimum period of time."

Small (FIG. 2, el. 82) discloses: *"BINGO GAME SELECTED CATEGORY #'S ARE COMPARED WITH BINGO SPACES AND MATCHED SPACES ARE REVEALED"*. The Examiner interprets this disclosure as showing that a first period of time during which the viewer may submit an entry to win a prize.

Small (FIG. 2, el. 98) discloses: *"FOR KENO GENERATE RANDOM KENO NUMBERS AND COMPARE AGAINST SELECTIONS"*. The Examiner interprets this disclosure as showing that a second period of time during which the viewer may submit an entry to win a prize and displaying individual advertisements to a viewer in series as claimed in Claims 23, 62 and 75 and the claims that depend therefrom.

In response to Applicant's argument (Amendment B; paper#15; p. 8, ll. 1-11) which alleges that "A distinct advantage of the Applicant's invention is that . . . the viewer cannot simply 'click through' an advertisement and receive the reward without having actually viewed the advertisement. . . . [even though Applicant's argument admits that] De Rafael discloses that each ad presents a question to the user to actively involve the user. . . .", the Examiner contends that if a viewer clicks through an advertisement no matter how rapidly or how slowly, the viewer will inherently view the advertisement.

In response to Applicant's argument (Amendment B; paper#15; p. 8, ll. 12-19) which alleges that "Claims 1-77 . . . require displaying an offer of an 'opportunity' to win

a prize to a period of time the advertisement has been displayed. . . .", the Examiner contends that Small ((corrected figure) FIG. 3, els. 41 & 55-56 in view of FIG. 2 as discussed above) shows "an offer of an 'opportunity' to win a prize to a period of time the advertisement has been displayed. . . ." where the offer is manifested by the phrase in Small ((corrected figure) FIG. 3) which proposes: *"SELECT 8 CATEGORIES"*.

In response to Applicant's argument (Amendment B; paper#15; p. 9, ll. 9-20) which alleges that the prior art references "lack any motivation to combine elements. . . .", this is not the case.

It is well settled in the law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); also,

It is well settled in the law that "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP 2144 RATIONALE DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127.

In this case, and throughout the prior Office Action the obviousness rejections (including the admitted Official Notice evidence concerning the dependent claims) have relied upon the knowledge generally available to one of ordinary skill in the art and the prior Office Action (notwithstanding the Official Notice evidence concerning the dependent claims) has detailed with particularity in the independent claims where the features of claims are suggested in the prior art references and where there are teachings (i.e., motivation) in the references to modify and/or combine the references to derive the present invention.

In response to Applicant's argument (Amendment B; paper#15; p. 9, ll. 9-20; p. 11, ll. 12-17; p. 12, ll. 13-18; and p. 13) which alleges that "a prima facie case of obviousness has not been made. . . .", this is not the case.

It is well settled that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested in the broadest interpretation to those of ordinary skill in the art. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is also well settled in the law that

> 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:
>
> (a) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
>
> (B) the difference or differences in the claim over the applied reference(s),
>
> (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
>
> (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. . . . (See MPEP 706.02(j)).

In this case, the Prior Office Action relies upon the combined teachings, suggestions and motivations found in the references as well as the knowledge generally available to one of ordinary skill in the art and does not include knowledge gleaned from the Applicant's disclosure. Furthermore, the Prior Office Action indicates the requisite "reasonable expectation of success" is established by virtue of combining the teachings of allowed patents to Small in view of De Rafael. Furthermore, the combination of the teachings in the prior art references suggests all the claim limitations. Finally, the teachings and suggestions to make the claimed combinations and the reasonable

expectation of success are both found in the prior art and not based on Applicant's disclosure; therefore, based on the above response, *prima facie* obviousness is established in the prior Office Action.

In response to Applicant's argument (Amendment B; paper#15; p. 10, ll. 19-22; and p. 11, ll. 1-17) which alleges that "neither Small nor De Rafael teach or suggest the use or benefits of limiting the period of time during which the viewer may submit an entry to win a prize, so that the opportunity is a fleeting opportunity. . . .", it is noted that the features upon which Applicant relies (i.e., "so that the opportunity is a fleeting opportunity . . . of time during which the viewer may submit an entry to win a prize. . . .") are not explicitly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

CONCLUSION

7. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Patent Examiner

August 11, 2003